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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/403,796 10/25/99 SHAH

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EXAMINER

QM12/0711

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GOODMAN, C

ART UNIT

PAPER NUMBER

3724

DATE MAILED:

07/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/403,796

Applicant(s)

SHAH, MUMTAZ

Examiner

Charles Goodman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

1. The Amendment filed on June 27, 2001 has been entered.

Continued Prosecution Application

2. The request filed on June 27, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/403,796 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Chuang. Chuang discloses a plastic film cutter comprising all the elements claimed including, *inter alia*, a unit (e.g. 308 in Figs. 3A-B); a lower part 323, 324, 325, 326 defining a sheet support surface (e.g. near 324 in Fig. 3C); an upper part 308; a gap (not designated by reference but see Figs. 3C-3D); a cutting blade 319, 320; pressure means 309-312; and a holder 329. See whole patent.

Regarding the phrase "capable of freely moving..." in claim 20, this has not been given significant patentable weight, since it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

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Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chuang in view of Shah (GB 2,223,976).

Chuang discloses the invention substantially as claimed except for matching sinusoidal surfaces on the upper and lower parts. However, Shah teaches a cutting device comprising upper and lower parts 3, 2 having matching sinusoidal surfaces (Fig. 6) which enhances tensioning of sheet material 1 to be cut. See Fig. 6, p. 4, ll. 6-15. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Chuang with the sinusoidal matching surfaces as taught by Shah in order to facilitate enhanced tensioning of the sheet material to be cut.

7. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chuang in view of Li.

Chuang discloses the invention substantially as claimed except for a window. However, Li teaches a window (the cut out portion above 24 in Fig. 1) which inherently serves as a means to visually observe the cutting action or the line of cut. See Fig. 1. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Chuang with the window as taught by Li in order to facilitate proper alignment and cutting of the sheet material.

8. Claims 20-22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view of Campbell Jr..

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Li discloses the invention substantially as claimed including upper and lower parts 1, 2, a gap therebetween (not designated by reference but see Fig. 1), a cutting blade 23, and a blade holder 22. See whole patent. However, Li lacks a pressure means. In that regard, Campbell Jr. teaches a cutter having a pressure means or roller 17 disposed immediately in front of a cutting blade 14 for the purpose of placing the sheet material to be cut under tension. See Figs. 2-5, c. 3, ll. 5-37. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Li with the pressure means as taught by Campbell Jr. in order to facilitate enhanced tensioning of the sheet material during cutting.

Regarding the phrase "capable of freely moving..." in claim 20, this has not been given significant patentable weight, since it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

9. Claims 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view of Campbell Jr. as applied to claims 20-22 and 24 above, and further in view of Shah (GB 2,223,976).

The modified device of Li discloses the invention substantially as claimed including substantially matching faces that facilitate sinusoidal shaping of the material to be cut and thereby provide tension. See Figs. 1-6. However, the faces themselves are not sinusoidal. In that regard, Shah teaches that sinusoidal matching faces is a well known face shape in the art. More specifically, Shah teaches a cutting device comprising upper and lower parts 3, 2 having matching sinusoidal faces (Fig. 6) which enhances

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tensioning of sheet material 1 to be cut. See Fig. 6, p. 4, ll. 6-15. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Li with the sinusoidal matching faces as taught by Shah in order to facilitate tensioning of the sheet material to be cut or to substitute the sinusoidal faces of Shah for the non-sinusoidal faces of Li, modified, since either shapes are deemed to be equivalent means of tensioning and to substitute one for the other would have been an obvious matter of design choice, and since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art, especially since such a change does not render unexpected or unobvious results. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Response to Arguments

10. Applicant's arguments filed June 27, 2001 have been fully considered but they are not persuasive.

In response to Applicant's basic argument that Chuang does not anticipate the claimed invention because Chuang lacks a unit "capable of freely moving in both linear and non-linear paths",¹ this argument is traversed. First, as noted in the rejection *supra*, this limitation in the claim has not been given significant patentable weight. Second, even if the limitation should be given weight, the unit disclosed in Chuang is fully capable of movement in the paths as claimed when the unit is used alone (both linear and non-linear) or on the rail (linear). Furthermore, what structure has Applicant set forth in the claim, besides the "capable of" recitation, that specifically limits the

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invention to cutting both linear and non-linear paths? What specific recited structure allows the claimed “unit” to cut non-linearly that is different from the prior art? There is nothing in the claim that specifically allows the claimed “unit” to cut in a non-linear path. Moreover, this recitation in the claim is related to the intended use of the device, and as such, it has not been given significant patentable weight, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The path of cut is defined by the user whether the user uses an alignment means that restricts the direction of the path or not. Thus, if a user wishes to cut a non-linear line, then the user merely pushes the cutter in the desired path. In sum, there is no patentable distinction between the structures of the prior art and that claimed. The same points applies to all similar arguments against the references.

In response to Applicant’s basic argument that Li in view of Campbell Jr. does not render the claimed invention obvious because Li’s invention is used to cut “wrappage” and cuts in a different manner than Applicant’s invention,² this argument lacks merit. First, it is noted that the Examiner’s comments in the last Office Action applies equally here.³ Applicant makes much about how both Li and Campbell Jr. are “intended” to be employed to cut in a linear path. However, without reiterating the Examiner’s rebuttal in detail from the last Office Action, suffice it to say that at least with respect to Li, there is nothing in Li that prevents a user from using the disclosed

¹ See Amendment C, Paper No. 10, p. 5, l. 9 - p. 6, l. 9.

² *Id.*, p. 6, l. 10 - p. 10, l. 22.

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cutter to cut non-linearly. Second, Appellant basically couches the argument against the references in the allegation that the combination would not be “capable of freely moving in both linear and non-linear paths.” This issue has been fully addressed *supra*. Third, it is irrelevant whether Campbell Jr. only cuts in a linear path since this is not the teachings relied on with respect to Campbell Jr. Moreover, it is further irrelevant since the primary reference, Li, already inherently includes this “capability” regardless of whether Li explicitly states in the specification. It is clearly apparent to one skilled or one of ordinary skill in the art that Li’s device is free to move in any desired path a user intends. That includes non-linear paths.

In response to Applicant’s basic argument that Campbell Jr. is not analogous art,⁴ it has been held that a prior art reference must either be in the field of Applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the Applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Campbell Jr. is within the field of Applicant’s endeavor, mainly, both are hand held devices used to cut paper, sheet, or web materials (there is no patentable distinction between envelopes and sheet material since an envelope is another form of sheet material and an envelope cutter is fully capable of cutting other sheet material). In addition and contrary to Applicant’s assertions, the Examiner’s statement of irrelevance of the degree in which Campbell Jr.’s invention has with respect to the disclosed invention is correct. First, it is already noted that Campbell Jr. is analogous

³ See last Office Action, Paper No. 8, p. 5, l. 13 - p. 6, l. 17.

⁴ Amendment C, p. 8, l. 19 - p. 10, l. 18.

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art in contraindication to Applicant's assertions. Thus, Applicant's assertions to the "degree" is irrelevant and non-distinguishing. Second, Campbell Jr. has been used as a teaching reference for the claimed "pressure means" and not as a reference obviating the claimed invention as a whole. Otherwise, Campbell Jr. would have been an anticipatory reference. Thus, Applicant's assertions are again irrelevant. Third, it is acknowledged that the disclosure defines the technical field of the invention, including the intended use of the invention, and not simply the claims. However, the issue at bar is not in the technical details of the invention nor is it in the intended use of the invention *per se*. The issue is whether or not the *claimed* invention is rendered obvious by the teachings of the prior art references and the knowledge of one of ordinary skill in the art. Applicant's assertions is more akin to an issue under 35 USC § 112, first paragraph rather than obviousness. Since the Examiner had not raise this issue, Applicant's assertions are irrelevant. Fourth, the Examiner's position on this issue is on par with the manner in which the claims must be construed. The claims are at the heart of determining patentability since it is the claims which define the meets and bounds of patent protection desired. The disclosure serves to breathe life and meaning to the claims, and as such, the disclosure does not serve to limit the claims. Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moreover, the main point of argument, i.e. the capability of cutting in both linear and non-linear paths, is functional and not worthy of patentable consideration. It is not even presented in a manner which may accord consideration under 35 USC § 112, sixth paragraph where the functional

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recitation may be given more weight. Even if it was so presented, it would not rise to the level of patentability since any “means” to so perform is purely within the hands of the user rather than any structure claimed or disclosed. Fifth, it is also acknowledged that consideration of the “functionality” and “utility” are important in evaluating the patentability of the claimed invention. However, it is not clear what relevance this assertion has with respect to the obviousness rejection. In an obviousness rejection, the “functionality” and “utility” of the claimed invention is already presumed. Otherwise, the Applicant would have received a rejection under 35 USC § 101 for non-utility and consequently, functionality. As noted above, the “capable of” recitation has not and should not be given any patentable weight in this situation, and this position applies in both anticipation and obviousness situations based upon the teachings of the prior art and the knowledge of the ordinary artisan. Even if the recitation should be given weight, it only requires the prior art to have the ability to so perform whether in an anticipation or obviousness capacity. In that regard, both Li and Campbell Jr. are fully capable of performing the same especially in the absence of any teachings in either references that would prevent the user from doing so. Sixth and perhaps most importantly, Campbell Jr. has been used to modify the device of Li and *not* the disclosed invention. Therefore, this has no bearing on the disclosed invention *per se*, i.e. with respect to the disclosed invention, the “degree” of relevance of Campbell Jr. is irrelevant. Moreover, while the claimed invention may cover the disclosed invention, the claimed invention also encompasses other devices or variants with the same structural limitations. In that regard and as noted in the rejection *supra*, Li includes all the structure claimed except for the pressure means. The “capable of” recitation defines no

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structure. Li also includes teachings relating to tensioning of the sheet material.

Campbell Jr. teaches the pressure means which performs the same function as claimed, and for the reasons stated in the rejection, it would have been obvious to the ordinary artisan to modify Li with the teachings of Campbell Jr.

In sum, Applicant's arguments fail to persuade.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**rinaldi.rada@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in

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the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.


Charles Goodman
Patent Examiner
AU 3724

cg 
July 10, 2001